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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,043

02/13/2004

Eliezer Rapaport

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10/05/2006

CONNOLLY BOVE LODGE & HUTZ LLP

P.O. BOX 2207

WILMINGTON, DE 19899-2207

EXAMINER

ANDERSON, JAMES D

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,043

Applicant(s)

RAPAPORT, ELIEZER

Examiner

James D. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgement is made of the Terminal Disclaimer filed 9/5/2006. As such, the ODP rejection of claims 1-2 and 4-12 as being unpatentable over U.S. Patent No. 6,723,737 is hereby **withdrawn**. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. Unfortunately, upon further consideration the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application. In light of the new rejections being applied against the pending claims, the finality of the previous Office Action is hereby **withdrawn**.

Status of the Claims

Claims 1-2 and 4-12 are currently pending and are the subject of this Office Action. This is a **Non-Final** Office Action.

Claim Rejections - 35 USC § 112 – First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-9 and 12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

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The claims are drawn to a method of inducing weight loss by administering “an antagonist of adenosine A1 receptor.” Antagonists of adenosine A1 receptors can include any agent that inhibits adenosine A1 receptors. Thus, the claims are drawn to a method of using a genus of agents that are defined only by biological activity.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of the complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present is that an agent antagonizes adenosine A1 receptors. However, there is no description of structural characteristics are required to retain this biological activity. Further, only two compounds are recited in the specification as being adenosine A1 receptor antagonists: theophylline and caffeine. Accordingly, in the absence of sufficient recitation of distinguishing characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath, Inc. v. Mahurkar, 19USPQ2d 111, clearly states, “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” (See page 1117) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed *supra*, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of “antagonist of adenosine A1 receptor”, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity

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or simplicity of the method of isolation or synthesis. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating or synthesizing it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

Therefore, only theophylline and caffeine, but not the full breadth of the claims, meets the written description provision of 35 U.S.C. § 112, first paragraph. Applicant is reminded that *Vas-Cath* makes it clear that the written description provision of 35 U.S.C. § 112 is severable from its enablement provision (see *Vas-Cath* at page 1115). See also *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement).

Claim 1, 2 and 4-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

In the amendment filed 7/24/2006, applicants amended claims 1, 2, 4, 5 and 6 to include administration of "inorganic phosphate." Page 8, lines 14-25 were pointed to as providing support for such an amendment. However, consideration of page 8 of the specification reveals no explicit disclosure of administering inorganic phosphate. As such, the amendment of the

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instant claims to recite administration of “inorganic phosphate” introduces new matter into the disclosure.

Claim Rejections - 35 USC § 112 – Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the instant case, the amendment of claims 4-11 deleted “-3” and added “2”. This is confusing because it leaves the dependency as “1 2”. It is not clear if this is “12” or “1 or 2” or “1 and 2”.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Anderson whose telephone number is 571-272-9038. The examiner can normally be reached on MON-FRI 9:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James D. Anderson, Ph.D.
Patent Examiner
AU 1614

September 18, 2006

Ardin H. Marschel 9/29/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER